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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,796	01/04/2001	Krystyna Roslan-Szulc	PK1201T1	3261

7590 06/05/2002
Horst M. Kasper
13 Forest Drive
Warren, NJ 07059

EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,796

Applicant(s)

ROSLAN-SZULC, KRISTYNA

Examiner

John J. Wilson

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cd

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

A supplemental amendment was filed on February 19, 2002, however, was not matched with this application when the Final Rejection was mailed on March 6, 2002, as such, the Final Rejection is hereby withdrawn and the amendments of February 19, 2002 and of May 13, 2002 have been entered and an action on the merits of all of the claims follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 2 and 3, an end in the shape of a "semi-sphere" was not disclosed in the original disclosure and constitutes improper new matter. The drawing shown a curved end, however, there is no teaching that the cure is part of a sphere. In claim 2, a wing angle of "not more than 180 degrees" was not disclosed in the original disclosure and constitutes improper new matter. In claim 3, rectangular sheets with edges, trapezoidal sheets with edges and wing sheets and opposing sheets that are joined sealingly at free edges were not

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disclosed in the original disclosure and constitute improper new matter. It is noted that as shown in the drawing, wings 4, which the specification teaches are flat, appear to be flat in a direction into the drawing sheet which would imply a rectangular shape rather than sheets that are joined at the edges as now being claimed. In claim 9, "rolling" was not disclosed in the original disclosure and constitutes improper new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisner et al (4728290) in view of Stearns (6095811) and Curry ((1742061). Eisner shows an elastic protective covering 10 made of a thermoshrinkable material, column 9, lines 15-25. The specific tolerance used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to find the best match for the intended instrument. Further the tolerance that the sleeve may make with an inferentially claimed instrument is an obvious matter of choice in the use of the sleeve with an inferentially claimed element. Eisner does not show an elliptical shape. Stearns shows a non-round cross section, see Fig. 2. It would be obvious to one of ordinary skill in the art to modify Eisner to include a non-round shape as shown by Stearns in order to better fit the intended instrument. The specific shape used is an obvious matter of

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choice in shape to the skilled artisan looking to best match the shape of the intended instrument. The above combination does not show hinged ends. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al () and Curry (1742061). Fife shows a heat shrinkable protective covering 71, column 3, lines 49-51, having a wing, see the "proximal pull tab" in Fig. 10. Fife does not show an end in the shape of a semi-sphere. Cooper shows a rounded end, Fig. 2a. It would be obvious to one of ordinary skill in the art to modify Fife to include a rounded end as shown by Cooper in order to make use of well known shapes for protective covers. The above combination does not show two hinged wings. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument. As to claim 3, Fife shows a flattened sheet in Fig. 4. The process of making is an obvious matter of choice in process steps to the skilled artisan. The specific shape of the cover is an obvious matter of choice in a non-critical shape of a known structure to one of ordinary skill in the art.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife. Fife shows employing a tubular protective covering 71 having a wing, see the "proximal pull tab" in Fig. 10, placing a dental instrument 112 into the cover and removing by pulling on the tab. To pull the tab in the direction of the body of the cover to remove would be an obvious matter of choice in the direction of pulling to one of ordinary skill in the art looking to remove a covering. The number of wings used is an obvious matter of choice in the number of a known element used to the skilled artisan.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fife as applied to claim 6 above, and further in view of Eisner et al. Fife does not show rolling the cover when removing. Eisner teaches turning the cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art.

Specification

New terminology used in the claims must find correspondence with the specification, for example, first and second tubular sections and an expanding tubular section. All new terminology must be checked. No new matter may be added to the claims or specification.

Response to Arguments

Applicant's arguments filed February 19, 2002 and May 13, 2002 have been fully considered but they are not persuasive. Applicant argues that Stearns does not teach the combination, however, the suggestion in Stearns is in the solving of the problem of fitting a sleeve to an instrument by matching the shape. As such Stearns solves the same problem and is therefore suggestive. Further, it is noted that there is no disclosure that points to the shape as being critical. The disclosure is directed to heat shrinking. The specific shape used to solve the problem of fitting the instrument it is intended to be used with is properly held to be obvious to one of ordinary skill in the art looking to match the shape of the instrument. That Curry requires an additional element, adhesive, does not obviate the showing of the structure used to meet the claim language. The hinged ends of Curry are for the purpose of folding to form, from a blank, a shape that better fits the instrument. One of ordinary skill in the art looking to solve the problem of using a blank to form a better fitting sleeve would find an obvious solution in Curry, and therefore, the combination is suggested and proper. Further, it is noted that the photos submitted do not appear to show any specific "hinge" structure. The ends appear to merely be extensions of the original sheets, that is, they merely are tabs which several of the prior art references show. Applicant included 14 pages of additional information about the device and critical feature that are an improvement over the prior art, much of the information being new and not originally disclosed in the 5 pages of the specification. Only remarks that correspond to the disclosure as originally filed are given weight.

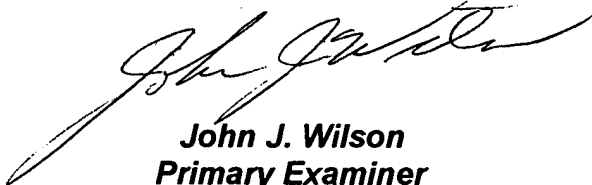
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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



**John J. Wilson
Primary Examiner
Art Unit 3732**

jjw
March 2, 2002
Fax (703) 308-2708